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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/775,889   | 02/09/2004  | Thadeus Schauer      | 226465              | 1284             |
| 23460  | 7590        | 07/05/2005           | EXAMINER            |                  |
| LEYDIG VOIT & MAYER, LTD<br>TWO PRUDENTIAL PLAZA, SUITE 4900<br>180 NORTH STETSON AVENUE<br>CHICAGO, IL 60601-6780 |             |                      | TUROCY, DAVID P     |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 1762                 |                     |                  |

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/775,889             | SCHAUER ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | David Turocy           | 1762                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 June 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. The applicant's amendments, filed 6/8/2005, have been fully considered and reviewed by the examiner. In light of the amendments to the specification and the abstract, the objections to such have been withdrawn. The examiner notes the amendments to claims. Claims 1-16 remain pending.

***Response to Arguments***

2. Applicant's arguments filed 6/8/2005 have been fully considered but they are not persuasive.

The applicant has argued the definition of solvolysis reaction is one which chemical bonds are ruptured in the solute resulting in the formation of a new compound and has present the IUPAC definition as evidence. Therefore, the term solvolysis will subsequently be given the submitted definition for the purposes of applying prior art, however during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" by giving words their plain meaning unless the specification provides a clear definition. See *In re Prater* 415 F.2d 1393 1404-05 162 USPQ 541 and *In re Zletz* 893 F.2d 319, 321, 13 USPQ2d 1320. Since sovolysis was given no clear definition in the specification, the term was given its broadest reasonable interpretation, which also includes a reaction between a solute and solvent to form another third compound, as defined by Merriam-Webster Dictionary.

The applicant has argued against the Cox reference stating that they do not teach of sovolysis. The examiner respectfully disagrees. Cox teaches a method of coating a solid particle with a polymeric material by dispersing the particles in a solution comprising a copolymer (Column 1, lines 39-43). Cox teaches precipitating atleast one, but not all, the components of the copolymer onto the particle, which would inherently result in the breaking of atleast one chemical bond of the copolymer resulting in a new polymer for deposition on the particle (Column 1, lines 41-50). Cox discloses bringing a solution of a polymer in a solvent and depositing the polymer onto the substrate (Column 4, lines 9-15).

The applicant has argued against the Klein reference stating Klein teaches of a polymeric dispersion and there is no disclosure about subjecting the polymer to a solvolysis reaction to thereby depositing the polymer on the surface of a substrate. Such an argument is not commensurate in scope with the rejected claims. The rejected claims only required a polymer in solution having the substituents as claimed whereby the substituents were solvolyzed, i.e. reacted to form a third compound, and bring the third polymer in solution into contact with the surface of the substrate. Klien teaches of a polymer having such substituents as claimed and subjecting the substituents to a reaction which results in form showing reduced solubility, where the rejected claim does not require precipitation onto the substrate.

The applicant has argued against the Klein reference stating that Klein does not teach of a polymer solution, however, the examiner respectfully disagrees. Klien

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discloses the invention is adapted to form colloids, solutions, dispersions, etc. (Column 6, lines 44-47).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-16 are indefinite because they are method claims dependant upon product claim 12. For the purposes of applying art the method claims 13-16 are dependent from claim 1.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 8, 10, 12, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 3393162 by Cox et al ("Cox").

These claims remain rejected for the same reasons as discussed in the office action dated 12/8/2004 and for the reasons set forth in section 2 above. In

addition Cox discloses coating metallic particles, in particular discloses coating aluminum flakes, which are inherently flat in structure (Column 1, lines 35-36, Example 8).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3393162 by Cox et al ("Cox") in view of "Addition Polymerization". Encyclopedia of Polymer Science and Engineering. Volume 1. New York. Pg 470-471.

This claim remains rejected for the same reasons as discussed in the office action dated 12/8/2004 and for the reasons set forth in section 2 above.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3393162 by Cox et al ("Cox") in view of "Surface Treatment of Organic Pigments". Pigment Handbook. Volume III. Page 165.

This claim remains rejected for the same reasons as discussed in the office action dated 12/8/2004 and for the reasons set forth in section 2 above.

5. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3393162 by Cox et al ("Cox")

Cox teaches all the limitations of these claims as discussed above in the 35 USC 102 (b) rejection, except, Cox fails to explicitly teach of a polymer have a molar mass from 1000 to 500000 g/mol. However, it is the examiners position that molar mass of a polymer is a cause effective variable and it is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

6. Claims 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3393162 by Cox et al ("Cox") in view of US Patent 3884871 by Herman et al ("Herman").

These claims remain rejected for the same reasons as discussed in the office action dated 12/8/2004 and for the reasons set forth in section 2 above.

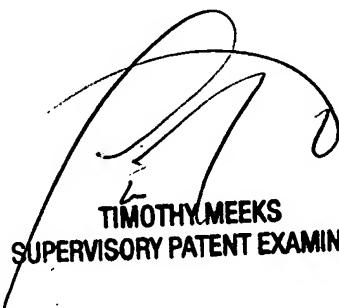
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy  
AU 1762



TIMOTHY MEEKS  
SUPERVISORY PATENT EXAMINER